

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow.

Claims 23, 29-33, 37-40, 42 and 48 are pending in the application, Claims 24-25, 27-28, 34, 36, 46 and 47 having been canceled above.

By the above amendments, Claims 23, 29-33, 37-40 and 42 are amended to depend from Claim 48 instead of canceled Claim 46 or claims, which depended directly or indirectly, from canceled Claim 46. Applicants also amended Claim 48 by canceling the formula (VII) and by correcting formula (IX).

Turning now to the Official Action, Claims 47 stands rejected under 35 U.S.C. §102(b) as being anticipated by Bailey (U.S. Patent No. 2,970,150). As Applicants have canceled Claim 47, this rejection is now moot.

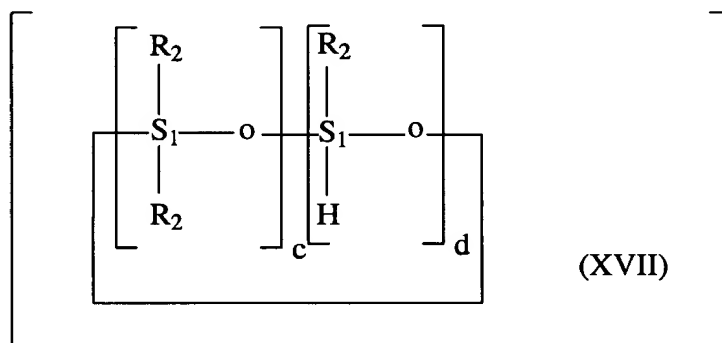
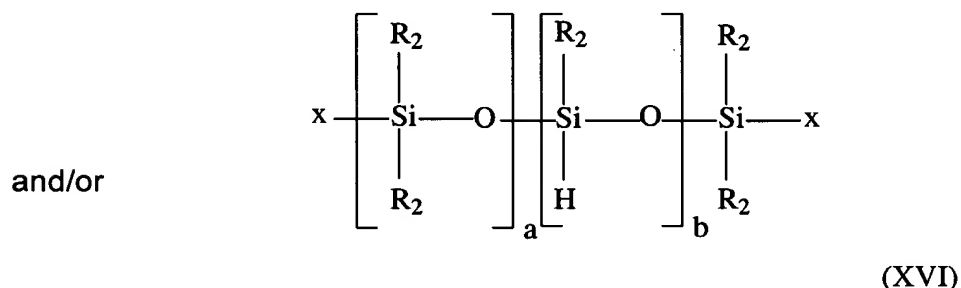
Claims 23-25, 27-34, 36-40, 42, 46 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bailey. For at least the reasons that follow, withdraw of the rejection is in order.

Claim 48 recites a process for the preparation of a nonturbid, functionalized silicone oil of stable viscosity, the process comprising: hydrosilylating polyorganohydrosiloxane with synthons wherein:

- (1) the synthons hydrosilylated with the polyorganohydrosiloxane are different or identical, comprising at least one hydrocarbon-comprising ring in which is included at least one oxygen atom,
- (2) said hydrosilylation reaction is carried out in the presence of a heterogeneous catalytic composition to reduce reactions that can form a gum and/or resin during

devolatilization, the heterogeneous catalytic composition comprising a metal selected from the group consisting of cobalt, rhodium, ruthenium, platinum and nickel deposited on an inert support, said inert support selected from the group consisting of carbon black, charcoal, alumina, silicate and barium oxide, and

(3) the polyorganohydrosiloxane is linear or cyclic and has the mean formulae:



in which:

- the symbols R_2 are identical or different and correspond to a monovalent hydrocarbon-comprising radical chosen from the phenyl radical and linear or branched alkyl radicals having from 1 to 6 carbon atoms;
- the symbols x are identical or different and correspond to a monovalent radical chosen from R_2 , a hydrogen atom, a methoxy radical and an ethoxy radical;
- a and b are integers or fractions, such that:

- $0 < a \leq 200$,

- $0 \leq b < 200$,

- and at least one of the two x groups corresponds to the hydrogen radical if b

= 0,

- $5 < a + b \leq 200$;

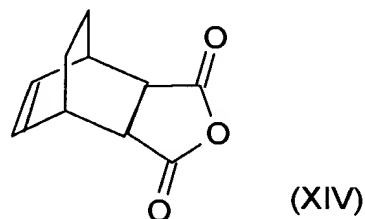
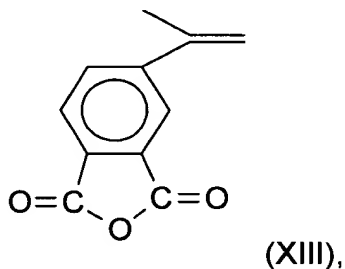
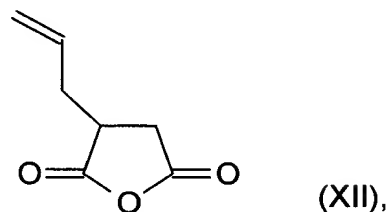
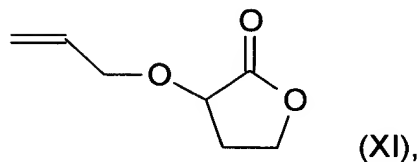
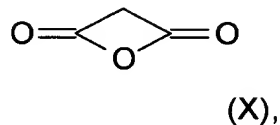
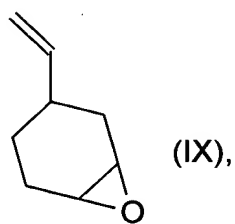
■ c and d are integers or fractions, such that:

- $0 < c < 5$,

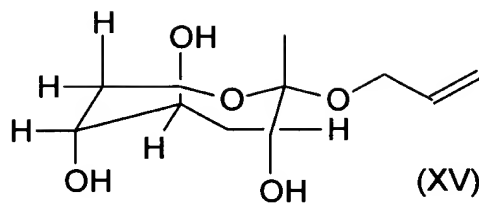
- $1 < d < 10$,

- $3 < c + d < 10$

wherein the synthon has the formula:



or



; and

(4) devolatilizing a silicone oil obtained from the hydrosilylation reaction.

(Emphasis added.)

The Official Action asserts that the only difference between Example 15 of Bailey and the claims is that the polyorganohydrosiloxane in Bailey does not meet formula (XVI) or (XVII). The Official Action further asserts that “. . . one having ordinary skill in the art would have found the selection of a polyorganohydrosiloxane meeting the formulae of (XVI) or (XVII) from the teachings of Bailey to have been obvious and well within experimentation.” (See Official Action at page 3.)

To establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest all of the claim elements. See In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). In addition, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” See In re Wilson, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970). See MPEP § 2143.03.

Applicants submit that Bailey does not disclose or suggest all of the elements of Claim 48. That is, Bailey does not disclose or fairly suggest a process for the preparation of a nonturbid, functionalized silicone oil of stable viscosity, comprising hydrosilylating polyorganohydrosiloxane with synthons having the chemical formulae (IX), (X), (XI), (XII), (XIII), (XIV) or (XV). Accordingly, because Bailey fails to teach or

suggest these claim elements, Bailey fails to establish a *prima facie* case of obviousness.

In addition, the rejection over Bailey fails to reflect a proper consideration of "all words" in Claim 48. In particular, because Bailey does not disclose or suggest a process that includes hydrosilylating polyorganohydrosiloxane with the synthons specified in Claim 48, Applicants submit that the rejection does not give full consideration to all claim elements, i.e., patentable weight must be given to the synthons having formulae (IX), (X), (XI), (XII), (XIII), (XIV) and (XV), in Claim 48 in judging the patentability of Claim 48 over Bailey.

Additionally, the rejection under § 103 over Bailey fails to consider the invention as a whole. In particular, Bailey does not disclose or fairly suggest a process that includes hydrosilylating polyorganohydrosiloxane with synthons having formulae (IX) - (XV), as recited in Claim 48, to prepare and nonturbid, functionalized silicone oil. Because Bailey fails to consider the problem of producing a nonturbid, functionalized silicone oil, Applicants submit that the process of Claim 48 would not have been obvious over Bailey for at least this additional reason.

For at least the above reasons, Claim 48 is patentable over Bailey. Because the remaining claims (Claims 23, 29-33, 37-40 and 42) depend, directly or indirectly, from Claim 48, these claims are also patentable over Bailey for at least the reasons that Claim 48 is patentable. Applicants respectfully request reconsideration and withdraw of the § 103(a) rejection over Bailey.

Claims 34-38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by or under 35 U.S.C. § 103(a) as obvious over Crivello (U.S. Patent No. 6,124,418). As Claims 34 and 36 have been canceled and Claims 37 and 38 have been

amended to depend from independent Claim 48 instead of canceled Claim 34,
Applicants submit that this rejection is now moot.

Claims 23-25, 27-34, 36-40, 42 and 46-48 stand rejected under the judicially-created doctrine of obviousness-type double patenting over Claims 1-16 of U.S. Patent No. 6,545,115. Applicants again request that this rejection be held in abeyance until an indication of allowable subject matter has been made. At that time, Applicants will evaluate the rejection to determine if a response is needed.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

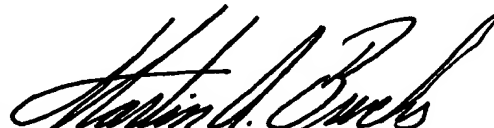
If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

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